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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,237	06/24/2002	Christian Hogn	RK7454PCT(US)	8864
49845	7590	08/03/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402			HARBECK, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/018,237	HOGLE ET AL.	
	Examiner	Art Unit	
	Timothy M. Harbeck	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/24/2002, 3/25/2004, 3/21/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A single means claim (Claim 12 in the present invention), i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are directed toward a system, however there is no structural element recited in the claim. The claims are rendered indefinite as a person of ordinary skill in the art cannot determine what the system is comprised of.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed toward a system however there is no accompanying structure for this system in the claimed language. It appears that the claims are directed toward software. Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (US 5,877,482).

Re Claim 1: Reilly discloses a method comprising:

- Receiving financial account identifier information of a user at a code allocation unit (Column 2, lines 19-45)
- Generating an access code for the user, the access code being to identify the user to a business entity (Column 1, line 59- Column 2 line 18) and;
- From the code allocation unit, effecting a value transfer utilizing the financial account identifier information and the access code, the access code being reflected in an amount of value associated with the value transfer (Column 3 lines 1-28)

Reilly does not explicitly disclose wherein the access code is transmitted to the user together with a receipt for the value transfer. However Reilly does disclose that this process occurs at an electronic funds transfer (EFT) terminal (Column 4, lines 16-28). Official Notice is taken that it was well known in the art at the time of invention for an EFT terminal to produce a receipt of a transaction to a customer (such as at an ATM machine, or a business entity credit card machine), including information from which to identify the specific transaction, often referred to as a confirmation number. It would

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have been obvious to a person of ordinary skill in the art at the time of invention to include this step to the disclosure of Reilly so that a user of the method would have a record of the transaction that can be easily recalled should there be any issues or discrepancies with said transaction in the future (i.e. double charging, claims of non-payment ect.).

Re Claim 2: Reilly discloses the method of claim 1 and further discloses wherein the value transfer is a money withdrawal transaction (Column 1, lines 11-17; "debit financial transactions).

Re Claim 3: Reilly discloses the method of claim 1 and further discloses wherein the generated access code is equal to the amount of money associated with the value transfer (Column 3, lines 22-23)

Re Claim 4: Reilly discloses the method of claim 1 and further discloses wherein the value transfer is a money deposit transaction (Column 1, lines 11-17; "credit financial transactions.")

Re Claim 5: Reilly discloses the method of claim 1 and further discloses wherein the effecting of the value transfer is by a remote data connection (Column 4, lines 15-28 and Fig 2)

Re Claim 6: Reilly discloses the method of claim 1 but does not explicitly disclose wherein the access code is to be transmitted to the user by one or more of a remote data connection and an account balance statement printer. However Reilly does disclose that this process occurs at an electronic funds transfer (EFT) terminal (Column 4, lines 16-28). Official Notice is taken that it was well known in the art at the

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time of invention for an EFT terminal to produce an account balance statement, via a printer, to a customer (such as at an ATM machine), including information from which to identify the specific transaction, often referred to as a confirmation number. It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step to the disclosure of Reilly so that a user of the method would have a record of the transaction that can be easily recalled should there be any issues or discrepancies with said transaction in the future (i.e. double charging, claims of non-payment ect.)

Re Claim 7: Reilly discloses the method of claim 1 and further discloses wherein the remote data connection is a computer network (Column 4, lines 15-28 and Fig 2) or an automated telephone interface.

Re Claim 8: Reilly discloses the method of claim 1 and further discloses wherein the access code comprises at least two partial codes (Column 3, lines 9-28).

Reilly does not explicitly disclose wherein a first partial code is transmitted to the user together with the receipt for the value transfer and a second partial code from the at least two partial codes is to be transmitted by an alternative method to the user. However Reilly does disclose that this process occurs at an electronic funds transfer (EFT) terminal (Column 4, lines 16-28). Official Notice is taken that it was well known in the art at the time of invention for an EFT terminal to produce a receipt of a transaction to a customer (such as at an ATM machine, or a business entity credit card machine), including information from which to identify the specific transaction, often referred to as a confirmation number. It would have been obvious to a person of ordinary skill in the

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art at the time of invention to include this step to the disclosure of Reilly so that a user of the method would have a record of the transaction that can be easily recalled should there be any issues or discrepancies with said transaction in the future (i.e. double charging, claims of non-payment ect.).

Furthermore, Reilly discloses the use of a variety of partial codes in order to encrypt and protect identifying information during a transaction (Column 4, lines 29-Column 5 line 35). This is done in order to alleviate existing problems with storing complete identification records in one transmission (Column 1, lines 25-32). Therefore it would have been obvious to a person of ordinary skill in the art at the time of invention to transmit any partial access codes or confirmation numbers separately in order to limit the risk of being obtained in whole by a third party.

Re Claim 9: Reilly discloses the claimed method 1 and further discloses receiving the identification data of the user at the code allocation unit (Column 2, lines 19-45).

Re Claim 10: Reilly discloses the claimed method 1 and further discloses wherein the financial account identifier information comprises at least one of a group including:

- Data associated with a credit card number of the user (Column 4, lines 44-50; "card data")

Re Claim 11: Reilly discloses the claimed method 1 but does not explicitly disclose receiving the receipt for the value transfer at the allocation unit. However as was discussed in claim 1, the process of Reilly occurs at an electronic funds transfer

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(EFT) terminal (Column 4, lines 16-28). Official Notice is taken that it was well known in the art at the time of invention for an EFT terminal to produce a receipt of a transaction to a customer (such as at an ATM machine, or a business entity credit card machine). It would have been obvious to a person of ordinary skill in the art at the time of invention to include this step to the disclosure of Reilly so that a user of the method would have a record of the transaction that can be easily recalled should there be any issues or discrepancies with said transaction in the future (i.e. double charging, claims of non-payment ect.)

Re Claims 12-22: Further system claims would have been obvious in order to implement the previously rejected method claims 1-11 respectively and are therefore rejected using the same art and rationale.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Souh can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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